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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/760,288      | 01/21/2004  | Ming-Hsiang Yeh      | BHT-3137-37         | 9850             |

7590 04/23/2007  
TROXELL LAW OFFICE PLLC  
SUITE 1404  
5205 LEESBURG PIKE  
FALLS CHURCH, VA 22041

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| EXAMINER |
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SAUNDERS JR, JOSEPH

|          |              |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

2615

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 04/23/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/760,288

Applicant(s)

YEH, MING-HSIANG

Examiner

Joseph Saunders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is the initial office action based on the communications filed January 21, 2004. Claims 1 and 2 are currently pending and considered below.

#### ***Specification***

2. The disclosure is objected to because of the following informalities: On page 1 line 14 and page 2 line 11 "USB (universal series bus)" should be corrected to "USB (universal serial bus)". Page 3 lines 17 – 21 contain grammatical errors.

Appropriate correction is required.

#### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 1 and 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/760,312 in view of Altare et al. (US 2002/0171567 A1), hereinafter Altare.

This is a provisional obviousness-type double patenting rejection.

**Claim 1:** Application 10/706,312 discloses an audio player comprising: a processor; a USB interface electrically connected to the processor for connection with other appliance; a controller electrically connected to the processor and having at least one key to correspond to and control options in the processor; a display electrically connected to the processor to display the selected option in the processor by the controller; a storage electrically connected to the processor to store information therein; a decoder electrically connected to the processor to decode digital audio information so that the digital audio information is converted to digital information, wherein the decoder is a MP3 decoder; and an analog/digital converter electrically connected to the decoder to convert the decoded digital information to audio signal to enable other appliance to properly play the audio signal directly (Claim 1). Application 10/760,312 *does not disclose* an infrared transmitter electrically connected to the processor to transmit and receive digital information. Altare discloses an audio player of similar design including all the components above and also includes an Infrared Transceiver 38b "for the purposes of data transfer to the other device". The device transfers digital data in the form of MP3 or related compressed information.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to include an Infrared Transceiver electrically connected to the processor to transmit and receive digital information as disclosed by Altare in the system disclosed by Application 10/760,312 since it is well known in the art to transfer digital information between two devices using infrared thereby allowing for an alternative data transfer method in lieu of or in addition to Universal Serial Bus (Altare, Paragraph 94 and 95).

**Claim 2:** Application 10/706,312 and Altare disclose the audio player as claimed in claim 1, and Application 10/706,312 further discloses wherein a buffer is sandwiched between the storage and the processor (Claim 3).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Altare et al. (US 2002/0171567 A1).

**Claim 1:** Altare discloses an audio player (Figure 1 – 4) comprising: a processor (Display/Keypad Processor 35); an infrared transmitter electrically connected to the processor to transmit and receive digital information (Infrared Transceiver 38b); a USB

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interface electrically connected to the processor for connection with other appliance (Universal Serial Bus 38a); a controller electrically connected to the processor and having at least one key to correspond to and control options in the processor (Keypad 37); a display electrically connected to the processor to display the selected option in the processor by the controller (Dot Matrix Display Module 36); a storage electrically connected to the processor to store information therein (Hard Disk 30); a decoder electrically connected to the processor to decode digital audio information so that the digital audio information is converted to digital information, wherein the decoder is a MP3 decoder (MP3 Encoder/Decoder 34); and an analog/digital converter electrically connected to the decoder to convert the decoded digital information to audio signal to enable other appliance to properly play the audio signal directly (Audio CODEC 33) (Paragraphs 89 and 93 – 96).

**Claim 2:** Altare discloses the audio player as claimed in claim 1, wherein a buffer (Memory 32) is sandwiched between the storage (Hard Disk 30) and the processor (Display/Keypad Processor 35) (Figures 1 – 4 and Paragraph 94).

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JS  
April 13, 2007



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**